The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte SUSANN MARIE KEOHANE, GERALD FRANCIS MCBREARTY,
SHAWN PATRICK MULLEN, JESSICA KELLEY MURILLO,
and JOHNNY MENG-HAN SHIEH

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Appeal No. 2006-3121
Application No. 10/165,083

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ON BRIEF

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Before RUGGIERO, BARRY, and MACDONALD Administrative Patent Judges.

MACDONALD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-10, 17-25, and 29-34, which constitute all the claims pending in this application.

The disclosed invention pertains to providing source information (i.e., information that identifies the source of text or other objects, such as copyright or authorship information) pertaining to an object originating from a first document and incorporating the source information into a second document automatically.

Specifically, source information is automatically retrieved responsive to cutting or copying the object from a first document. The source information is then incorporated into the second document responsive to pasting the object into the second document.

Representative claims 1 and 31 are reproduced as follows:

1. A method in a data processing system for automatically providing source information associated with an object, the method comprising the computer-implemented steps of:

in response to an operation that copies an object contained in a first document to a first buffer, requesting source information associated with the object from a first application displaying the first document;

retrieving the source information from the first application displaying the object; and

in response to an operation that pastes the object to a second document, sending the source information to a second application displaying the second document, wherein the second application incorporates the source information into the second document in association with the object; and

displaying the second document.

31. A computer program product in a computer readable medium for managing source information, the computer program product comprising:

responsive to detecting an operation that pastes an object into a document in a target application, first instructions for obtaining source information for the object from a source application from which the object was copied;

second instructions for sending the source information to the target application;

third instructions for incorporating the source information into the document; and

fourth instructions for displaying the document.

The examiner relies on the following references:

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| Burner et al. (Burner) | 6,282,548 | Aug. 28, 2001 |
| Jones et al. (Jones) | 6,493,731 | Dec. 10, 2002<br>(filed Jan. 27, 1999) |

Screenshots of Microsoft (MS) Word 2000, Microsoft Corp., 1999 ("Word").

The following rejections are on appeal before us:

1. Claims 1-10, 17-25, and 29-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of Burner and further in view of Word.

2. Claim 31 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.[1]

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

## OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the prior art rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set

[1] This rejection was first presented in the examiner's answer and therefore constitutes a new ground of rejection under 37 CFR 41.39(a)(2). Although the examiner did not strictly comply with the requirements of MPEP § 1207.03(I), we nonetheless consider this procedural error harmless since appellants responded to the merits of the new ground of rejection in the reply brief [see reply brief, pages 2 and 3].

forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the invention as set forth in the claims on appeal. Moreover, we find that claim 31 is directed to non-statutory subject matter under 35 U.S.C. § 101. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the

requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000)). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

Regarding the independent claims, the examiner's rejection essentially finds that Jones teaches every claimed feature except for (1) requesting source information associated with an object from a first application in response to copying an object in a first document to a buffer, and (2) incorporating the source information into the second document responsive to pasting the object to the second document. Regarding difference (1), the examiner cites Burner as teaching requesting a web page for which metadata is displayed. The examiner finds that, in view of Burner, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jones to request a web page for which metadata is displayed so that metadata corresponding to a web page is displayed along with the web page. Regarding difference (2), the examiner cites Word as teaching copying and pasting text associated with footnotes from one document to another. The examiner finds that, in view of Word, it would have been obvious to one of ordinary skill in the art at the time of the invention to include in Jones the feature of copying the footnote information from one document and pasting into another to identify and associate metadata with its corresponding content [answer, pages 3-7].

With respect to the independent claims, appellants first contend that the prior art does not disclose or suggest the limitation calling for, in response to an operation that copies an object contained in a first document to a first buffer, requesting source information associated with the object from a first application displaying the first document. Appellants also contend that the prior art fails to disclose or suggest the limitation calling for, in response to pasting the object to a second document, sending the source information to a second application displaying the second document, wherein the second application incorporates the source information into the second document in association with the object [brief, page 11].

In support of these arguments, appellants first note that neither Jones nor Burner passes source information from one application to another responsive to a copy-and-paste operation. Although appellants acknowledge that Word has the ability to move or copy a footnote when the corresponding reference to that footnote is copied, the skilled artisan would not equate a footnote with "source information" as claimed. In this regard, appellants contend that a footnote is part of the <u>content</u> of the document, but source information is <u>metadata</u> for the document [brief, page 11; emphasis added]. According to appellants, unlike Word, the claimed invention (1) retrieves specific <u>metadata</u> (<u>i.e.</u>, "source information") from a first document, and (2) incorporates that "source information" into a second document [brief, pages 11 and 12; reply brief, page 5].

The examiner responds that appellants' arguments are not commensurate with the claim language. Specifically, the examiner notes that the broadest reasonable interpretation of "source information" is not limited to specific metadata, but can include information that is entered by the user -- an interpretation that fully comports with appellants' specification [answer, pages 11 and 12]. Applying this interpretation, the examiner argues that the "source information" limitation is taught by Word's footnotes and associated text in that the user can enter "source information" associated with the footnote, and such "source information" is copied and pasted into a second document [answer, pages 11 and 12].

Appellants also argue that the examiner's stated motivation to combine the references is problematic because such a position requires two disparate definitions of "source information." That is, Jones' and Burner's "source information" refers to metadata, but Word's "source information" refers to footnotes that are part of the document (i.e., not metadata) [brief, page 14]. The examiner argues that Word also refers to metadata-based "source information" in that Word enables a user to copy metadata and paste metadata from one document to another [answer, pages 15 and 16].

We will sustain the examiner's rejection of the independent claims. In our view, the term "source information" is not limited to metadata as appellants argue, but rather encompasses a wide variety of information – including footnotes. Indeed, appellants' claim 2 expressly includes footnotes as a type of

"source information." In any event, nothing in the claim language precludes footnotes as constituting "source information" – even footnotes that are part of a document's content.

Turning to the prior art, we note that Word enables the user to copy a footnote reference (i.e., an "object") located in the main text of a first document in a first application, and paste it in a second document displayed by a second application. Responsive to pasting, the associated "source information" (i.e., footnote number and associated text) is retrieved, sent to the second application, and automatically incorporated into the second document. As is well known in the art, such functionality exists not only when copying and pasting footnotes between independent documents within MS Word itself, but also between MS Word and other applications (e.g., between MS Word and MS Powerpoint).

In view of the ability of Word to automatically copy and paste footnotes and associated "source information" among multiple documents in diverse applications, we conclude that Word at least suggests the limitations of the independent claims. Therefore, we will sustain the examiner's obviousness rejection on the teachings of Word alone. Although we consider Jones and Burner to be merely cumulative to the teachings of Word, we may nevertheless rely on less than the total number of references relied on by the examiner in affirming a multiple-reference rejection under 35 U.S.C. § 103. In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266- 67 (CCPA 1961); In re Boyer, 363 F.2d 455, 458 n.2, 150 USPQ 441, 444 n.2 (CCPA 1966).

For at least the above reasons, we will sustain the examiner's rejection of independent claims 1, 17, 23-25, and 29-31. Since appellants have not separately argued the patentability of dependent claims 2, 4, 6-8, 10, 18, and 20-22, these claims fall with independent claims 1 and 17. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). See also 37 CFR § 41.37(c)(vii).

We will also sustain the examiner's rejection of claims 3 and 5.[2] The scope and breadth of the term "window manager" does not preclude the windows-based functionality of Word to automatically request and extract "source information" (footnotes and associated text) responsive to copy and paste operations as claimed.

Regarding claims 9, 19, and 32-34,[3] we find that the limitation calling for "automatically setting up a footnote" is reasonably suggested by Word's ability to automatically initiate, assign, locate, and organize footnotes. In short, the scope and breadth of the claim language does not preclude such functionality. Therefore, we will sustain the examiner's rejection of claims 9, 19, and 32-34.

We next consider the examiner's rejection of claim 31 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The examiner argues that the scope and breadth of the preamble of claim 31, particularly when read in light of the specification, encompasses non-statutory subject matter in the form of transmission-type computer readable media. Specifically, the preamble of claim

[2] Appellants indicate that claim 3 exemplifies the claims in this group [brief, page 15].
[3] According to appellants, claim 9 exemplifies the claims in this group [id.].

31 recites, in pertinent part, "[a] computer program product in a computer readable medium…." [answer, page 9; emphasis added]. Turning to the specification, the examiner notes appellants expressly identify two types of computer readable media: (1) recordable-type (e.g., floppy disks, hard disks, CD-ROMs, etc.), and (2) transmission-type (e.g., wired or wireless communication links using transmission forms, such as RF or lightwave transmissions) [id.; specification, page 16]. In short, the scope of claim 31 includes non-statutory transmission-type media.

The examiner, however, contrasts claim 31 with claim 25 which the examiner contends recites statutory subject matter. Specifically, the examiner notes that claim 25 recites that the computer program product is stored in a computer readable medium. Accordingly, the computer readable medium is limited to recordable-type (i.e., statutory) forms. The computer program product of claim 31, however, is merely "in" a computer readable medium and consequently impermissibly includes non-statutory transmission-type media [answer, pages 9 and 10].

Appellants respond that claim 31 recites functional descriptive material that renders the claim statutory under § 101 since such functional descriptive material is recorded on "some" computer readable medium. Appellants emphasize that the MPEP does not distinguish between various types of media that are considered to be statutory and non-statutory [reply brief, pages 2 and 3].

We will sustain the examiner's rejection of claim 31 under 35 U.S.C. § 101. At the outset, we find that appellants' description of transmission-type media on page 16 of the specification as including "wired or wireless communications links using transmission forms, such as, for example, radio frequency and lightwave transmissions" certainly implicates carrier waves and signals despite the absence of such terms in the description.

That said, the issue, quite simply, is whether a claimed computer program product that is broad enough to include transmission-type media -- media that includes carrier waves and signals -- is statutory subject matter. We acknowledge that we are unaware of any case law that has specifically decided this question either way. It could be argued that a carrier wave or signal is not statutory subject matter because it does not fall within any of the four categories of statutory subject matter.[4] In this instance, claim 31 includes both statutory and non-statutory subject matter that, according to recent proposed USPTO interim guidelines, must be amended to recite solely statutory subject matter.[5]

Even if a carrier wave or signal could be considered to be an article of manufacture, however, we find that such a carrier wave or signal does not operate as the claimed computer program product. Claim 31 recites a computer

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[4] See, e.g., Ex Parte Hartmann, No. 2006-1607, 2006 WL 2700810, at 4 (B.P.A.I. 2006) (non-precedential) ("'Signals' are not statutory subject matter. A case involving this issue is presently on appeal to the Federal Circuit: In re Nuijten, No. 06-1301."). See also "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," 1300 Off. Gaz. Pat. Office 142, Annex IV(c) (Nov. 22, 2005).

[5] See "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," 1300 Off. Gaz. Pat. Office 142, § IV(C)(2) (Nov. 22, 2005) ("[A] claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application.").

program product for managing source information where the product comprises instructions that interact with the computer to perform specific functions. It is our view that the computer cannot perform the claimed functions while the instructions are within a carrier wave or a signal.

Specifically, information sent by carrier waves or signals is transmitted by modulating the carrier wave or signal with the information. This information must be received and demodulated before the information is available for use. Thus, the information, while on the carrier wave or signal, is unavailable to the computer for performing the functions recited in claim 31. It is also likely that all the information necessary to perform the functions of claim 31 never exists within the carrier wave or signal at any one time. In other words, it is typical for information that is transmitted by carrier wave or signal to begin to be received at the receiver before all the information is transmitted. Therefore, it appears to us that a computer program product for carrying out the claimed invention cannot exist while the information is being transmitted on a carrier wave or signal.

For the above reasons, we find that claim 31 recites non-statutory subject matter.[6] Accordingly, we will sustain the examiner's rejection of claim 31 under 35 U.S.C. § 101.

[6] Although not before us on appeal, similar considerations apply to claim 25. Although the examiner finds claim 25 statutory since the computer program product is "stored in" a computer readable medium (as opposed to merely being "in" the medium), we find such a distinction does not negate non-statutory subject matter (i.e., carrier waves or signals) from being included in claim 25 for the reasons that we discussed with respect to claim 31. In our view, merely reciting that the product is stored in a computer readable medium does not preclude such storage to occur in transmission-type media (e.g., carrier waves or signals). Accordingly, the examiner should reconsider whether claim 25 complies with 35 U.S.C. § 101.

In summary, we have sustained the examiner's rejection with respect to all claims on appeal. Therefore, the decision of the examiner rejecting claims 1-10, 17-25, and 29-34 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

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| JOSEPH F. RUGGIERO<br>Administrative Patent Judge | ) | |
| LANCE LEONARD BARRY<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| ALLEN R. MACDONALD<br>Administrative Patent Judge | ) | |

ARM/jaj/rwk

IBM CORP (YA)
C/O YEE & ASSOCIATES PC
P.O. BOX 802333
DALLAS, TX 75380